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10/091,820	03/06/2002	Harald Bothe	CL/V-31891A	8432

1095 7590 08/27/2003

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EXAMINER

VARGOT, MATHIEU D

ART UNIT PAPER NUMBER

1732

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,820

Applicant(s)

BOTHÉ et al.

Examiner

M. JARGOT

Group Art Unit

1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 + 5

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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1. The USPTO is participating in a search exchange pilot program with the European Patent Office (EPO). As part of the pilot program, the USPTO has received a copy of the Search Report prepared by the EPO on the counterpart EP application for which priority under 35 U.S.C. 119(a) is claimed. The references cited in the EPO Search Report have been considered by the examiner and have been listed on the PTO 892 form, if necessary. A copy of these references is not being furnished to applicant with this office action. It will not be necessary for applicant to submit these references in an information disclosure statement.

2. Claims 3, 5-8 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 1, recites a "radical according to claim 2" when claim 2 is directed to a process. Applicant should change "radical" in claim 3 to --process-- for clarity. Also, in claims 5-8 and 13, applicant defines the "further polymer" set forth in claim 1 by using the language "polymerizable group" when the term "crosslinkable groups" is used in claim 1. For clarity, the occurrences of "polymerizable" in claims 5-8 and 13 should be changed to --crosslinkable--.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5 and 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Publication WO 99/26087.

The applied reference discloses the instant method for making a molding by preparing an aqueous solution comprising a water-soluble prepolymer with crosslinkable groups (see the last two paragraphs of page 2 and the first paragraph of page 3), adding a further polymer which is devoid of crosslinkable groups (see the second full paragraph of page 12), introducing the solution into a mold, triggering the crosslinking and opening the mold to remove the molding. See page 2, first paragraph. Concerning instant claims 2-4, see pages 4-5; photoinitiators as required in instant claim 9 are disclosed at the paragraphs bridging pages 13 and 14; instant claim 10 is taught at the third paragraph from the bottom of page 17; the limitations of claims 11, 12 and 14 (ie, the products made) can be found in the last paragraph of page 19. It is submitted inherent that the mixture of the prepolymer and further polymer forms a clear aqueous solution (in the absence of any tinting agent) as set forth in instant claim 5 in that most polymers in solution are generally colorless unless dyed. Hence, although the further polymer in PCT -087 contains a pigment when added to the prepolymer, it is submitted inherent, that in the absence of such pigment, the two polymers would form a clear aqueous solution and hence instant claim 5 is met. Given that the further polymer is disclosed as constituting 1-60% by weight of the pigment dispersion (see bottom of page 12) and a simple calculation involving the aqueous formulation of Example 5 shows that the pigment dispersion is 8.37% by weight of the entire aqueous solution, it is

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submitted that the concentrations recited for the further polymer in instant claims 8 and 13 are met.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT

Publication WO 99/26087.

PCT -087 discloses the basic claimed method lacking a clear disclosure of the further polymers as recited in instant claims 6 and 7. However, page 8, second-to-last paragraph in the applied reference teaches that the crosslinkable prepolymer would be copolymerized with units such as ethylene, propylene, acrylamide, dimethacrylamide and vinyl pyrrolidone. If such moieties would be present in the prepolymer, and the applied reference repeatedly suggests that the further polymer can be the same as the crosslinkable prepolymer (except it does not have the crosslinkable groups), then clearly it would have been obvious to one of ordinary skill in the art at the time of invention to have utilized such polymers in lieu of polyacrylic acid and PVA taught at 12 of the reference.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621. The examiner can normally be reached on Mon-Fri from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaanni, can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is 703 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

August 21, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300  
0/21/03